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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,263	12/27/1999	LARRY D. KINSMAN	3399.2US	9776

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BRICK G POWER
TRASK BRITT & ROSSA
P O BOX 2550
SALT LAKE CITY, UT 84110

EXAMINER

CRUZ, LOURDES C

ART UNIT PAPER NUMBER

2815

DATE MAILED: 11/30/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/473,263

Applicant(s)

KINSMAN, LARRY D.

Examiner

Lourdes C. Cruz

Art Unit

2815

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 and 8-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Beilstein, Jr. et al. (US 5786628).

Beilstein teaches a vertical surface mount semiconductor device, comprising:

A semiconductor device 13; bond pads (15) on a surface of said device and adjacent an edge thereof and arranged substantially in line; bumps 29 disposed adjacent selected bond pads, each bump configured to form a conductive joint between one of said selected bond pads and a corresponding terminal 53 of a substrate 41.

See that Beilstein also teaches:

- Bumps adjacent to the bond pads (**Claims 2,12 and 20**)
- A support (to the left of 13) layer 19 (**Claims 3,4-6,10,11,15-17, and 21-23**). See page 8 of the disclosure, lines 4-5.
- Joints 27 adjacent said bond pads (**Claim 14**)
- A Semiconductor device laminated to an adjacent one (**Claims 8,18 and 24**).

Regarding **Claim 19**, see that all the structural limitations recited in the claim have been addressed above. However, the claim also recites an intended use. See In re Pearson

181 USPQ 641 (CCPA) which makes clear that terms merely setting forth intended use for, or a property inherent in, an otherwise old composition do not differentiate claimed composition from those known to prior art. See also, *In re Swinehart* [169 USPQ 226] (CCPA 1971) which makes clear that mere recitation of a newly discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-24 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-21 of prior **U.S. Patent No. 6140696**. This is a double patenting rejection. Although the claims of the instant Application and the claims of Patent No. 6140696 are not the same, the subject matter there between is identical. That is, the semiconductor device defined in the instant Application inherently includes "an edge, an active surface, and a back side opposite said active surface".

Response to Arguments

Applicant's arguments filed 9-10-01 have been fully considered but they are not persuasive. Regarding the double patenting rejection in view of US 6140696, see that the new language does not overcome this rejection. The newly added language

"substantially in line" is inherent in the claims of Kinsman since bond pads are defined as being "proximate said edge", meaning they must be substantially in line. Furthermore, if they were not "substantially in line" the semiconductor device could not be a vertical surface.

Additionally, and referring to the remarks filed with the amendment, these arguments are not persuasive since the examiner has pointed out 15 as the bond pad and applicant has failed to point out why 15 does not read on this "bond pads".

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

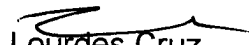
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See that Choi (US 6198164) teaches vertically mounted semiconductor devices laminated to one another using a heat dissipating material.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lourdes C. Cruz whose telephone number is 703-306-5691. The examiner can normally be reached on M-F 8:00- 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eddie Lee can be reached on 703-308-1690. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Lourdes C. Cruz
Examiner
Art Unit 2815


Lourdes Cruz
November 18, 2001


EDDIE LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800